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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,134	08/23/2001	Joseph E. Hooten	5008-0002	1714

7590	08/24/2006

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EXAMINER
KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/938,134	HOOTEN, JOSEPH E.
		Examiner	Art Unit	
		Vivek D. Koppikar	3626	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>01 August 2006</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-7,12,14-20 and 24</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-7, 12, 14-20 and 24</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____.

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

1.   Claims 1-7, 12, 14-20 and 24 have been examined in this application. This Final Office

Action is in response to the "Amendment" and "Remarks" filed on August 1, 2006.

Claim Objections

2.   Claim 7 is objected to because of the following informalities: On line 2 of Claim 7, the

word "to" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 1-7, 12, 14-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable

over "Viruses and Forged Faxes Now Get Insurance Protection" published in Newsbytes on

February 19, 1991 (hereinafter referred to as "Newsbytes") in view of US Patent Number

6,347,302 to Joao.

(A)   As per claim 1, Newsbytes teaches a system for insuring a customer having a

computer against damage caused by a computer virus (Newsbytes: Paragraph 1), said system

comprising:

a computer (Newsbytes: Paragraph 1);

an insurer providing insurance coverage against computer virus infection of said

computer (Newsbytes: Paragraphs 1 and 6); and

wherein said insurer provides compensation to the customer when said computer becomes infected with a virus (Newsbytes: Paragraphs 1 and 6-7)

Newsbytes does not teach the following features which are taught by Joao:

means (e.g. payment of a claim) for repairing the computer (Joao: Col. 2, Ln. 7-18 and Col. 2, Ln. 58-Col. 3, Ln. 13) and wherein the insurer provides means for repairing the computer (Joao: Col. 2, Ln. 58-Col. 3, Ln. 13).

Newsbytes teachings compensating an insured (customer) when the insured's (customer's) computer becomes infected with a virus but Newsbytes does not teach providing a means for repairing a computer when the computer becomes infected with a virus, however, as noted above, this feature is taught by Joao. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Newbytes with the aforementioned teachings from Joao with the motivation of providing an insured with a means of covering liabilities (e.g. bills or payments due) arising from repairs of computer equipment, as recited in Joao (Col. 2, Ln. 7-18 and 58-65).

(B)   As per claim 2, the combined system of Newsbytes in view of Joao does not teach a means for repairing the computer includes providing a repair center for which the customer may bring the infected computer to the repair center repairing the infected computer at the repair center, however, the examiner takes Official Notice that this feature is well known in the insurance industry. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Newsbytes in view of Joao with the aforementioned teaching with the motivation of providing an insured with a means of having their article or possession (computer) repaired.

(C)   As per claims 3-4, the combined system of Newsbytes in view of Joao does not teach or

suggest that the means for repairing the computer includes replacing any software infected by the

computer virus nor does it teach replacing any hardware component of the computer infected by

the computer virus nor does it teach repairing the infected computer by providing a replacement

computer component to replace the damaged computer component caused by the computer virus,

however, the examiner takes Official Notice that this feature is well known in the insurance

industry. At the time of the invention, it would have been obvious for one of ordinary skill in the

art to have modified the combined teachings of Newsbytes in view of Joao with the

aforementioned teachings with the motivation of providing an insured with a means of having

their computer repaired and restored to its normal state.

(D)   As per claim 5-6, the combined system of Newsbytes in view of Joao does not teach a

means for repairing the computer which includes a means for providing and fielding a field

technician by the insurer to the location of the computer to repair the infected computer nor does

it teach a means for repairing the computer which includes a means for remotely repairing the

computer, however, the examiner takes Official Notice that this feature is well known in the

insurance industry. At the time of the invention, it would have been obvious for one of ordinary

skill in the art to have modified the combined teachings of Newsbytes in view of Joao with the

aforementioned teaching with the motivation of providing an insured with a convenient means of

having their computer repaired with does not require the insured (customer) to travel to the repair

shop.

(E)   As per claim 7, the combined system Newsbytes in view of Joao includes a means for

repairing the computer which includes providing the customer with a monetary award based on

the loss of earnings (i.e. liability arising from the damage of the computer) due to the time the

computer is unable to operate because of the virus (Newsbytes: Paragraphs 6-7) and Joao (Col.

13, Ln. 34-38). The motivation for making this modification to the teachings of Newsbytes is

the same as that set forth in the rejection of claim 1, above.

(F)   As per claim 12, Newsbytes teaches a method of insuring a customer having a computer

for damage caused by a computer virus, said method comprising the steps of: offering, by an

insurer, coverage of a computer for damage caused by a computer virus to the customer;

selecting, by the customer, coverage offered by the insurer; and buying, by the customer, offered

coverage and upon the computer being infected by a computer virus compensating the customer

(Newsbytes: Paragraphs 1-6 and 7).

Newsbytes does not teach the step that where upon the computer is infected by a

computer virus, requesting repair by the customer for the damage caused and repairing the

damaged (infected) computer by the insurer, however, this feature is taught by Joao (Col. 2, Ln.

7-18; Col. 2, Ln. 58-Col. 3, Ln. 13). At the time of the invention, it would have been obvious for

one of ordinary skill in the art to have modified the combined teachings of Newbytes with the

aforementioned teachings from Joao with the motivation of providing an insured with a means of

covering liabilities (e.g. bills or payments due) arising from repairs of computer equipment, as

recited in Joao (Col. 2, Ln. 7-18 and 58-65).

(G)   As per claims 14-18, these claims repeat features previously addressed in the rejections of

claims 1-7 and 12 and are therefore rejected on the same basis.

(H)   As per claim 24, Newsbytes teaches method of insuring a customer having a computer

for damage caused by a computer virus (Newsbytes: Paragraph 1), said method comprising the

steps of:

offering, by an insurer, coverage of a computer for damage caused by a computer virus to

the customer (Newsbytes: Paragraph 1);

selecting, by the customer, coverage offered by the insurer (Newsbytes: Paragraph 1);

buying, by the customer, offered coverage (Newsbytes: Paragraph 1);

infecting the computer by a computer virus (Newsbytes: Paragraph 6);

upon the computer being infected with a computer virus , requiring the customer to fulfill

at least one prerequisite to be covered in the event of damage caused by the computer virus

(Newsbytes: Paragraph 7);

requesting compensation by the customer for damage caused by the computer virus

(Newsbytes: Paragraphs 1 and 6); and

Newsbytes does not teach the step of repairing the computer by the insurer, however, this

feature is taught by Joao (Col. 2, Ln. 7-18; Col. 2, Ln. 58-Col. 3, Ln. 13). At the time of the

invention, it would have been obvious for one of ordinary skill in the art to have modified the

combined teachings of Newbytes with the aforementioned teachings from Joao with the

motivation of providing an insured with a means of covering liabilities (e.g. bills or payments

due) arising from repairs of computer equipment, as recited in Joao (Col. 2, Ln. 7-18 and 58-65).

Response to Arguments

5.   Applicant's arguments filed on August 1, 2006 with respect to claims 1-7, 12, 14-20 and

24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Application Publication 2003/0220812to Jones teaches a feature wherein an insurance company calls various repair service providers to arrange for repairs on an insured's (personal) property (Jones: Section [0006]).

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,

Vivek Koppikar

8/4/2006

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER